REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 9, 17, 26, 32 and 38 have been amended. Antecedent basis is located throughout Applicant's specification and the original claims. Claims 25, 31, 37, 43, 44 and 45 have been cancelled. Claims 1, 2, 5-10, 13-18, 21-24, 26, 28-30, 32, 34-36, 38, 40-42 and 46-51 are pending.

Rejection of the claims

In the Office Action, independent claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0162842 ("Ono").

Claim 1 recites:

> 1. A method performed by a computer system, comprising:
> storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper;
> at a first location within the electronic version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference at the first location is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
> in response to the detected reference at the first location, embedding a hyperlink within at least part of the detected reference at the first location, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device.

In MPEP § 2131, the PTO provides that:

> *"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, to sustain a rejection of claim 1, Ono must contain all of the above-recited elements in claim 1. However, Ono fails to teach the combination of elements in claim 1. In fact, Ono teaches away from such a combination.

Regarding Ono, the Office Action states, "The KWIC and abstract documents are interpreted as locations within the version and both contain information extracted from the original version." Also, the Office Action states, "The examiner proposes that the computerized document, the KWIC document, and the abstract document are displayed on a display device as a likeness of the paper." If the Office Action is correct, then Ono clearly teaches away from claim 1, because

claim 1 requires that the second location is ***external*** to the paper.

Moreover, Ono fails to embed its ***clickable*** link within the original document (nor within the KWIC document) at the location where Ono actually detected the keyword. Instead, Ono embeds its clickable link within the ***abstract*** document. In Ono, FIG. 12 shows an example of the abstract document. In paragraph [0156], Ono states, "'Internet' and 'Intranet' indicated by bold letters in the display in FIG. 12 are clickable and links ***to*** corresponding portion of the KWIC document are embedded therein" (emphasis added). Accordingly, in the last sentence of paragraph [0156], Ono states, "That is, the display is changed as shown in FIG. 14."

Thus, Ono clearly teaches away from claim 1, because claim 1 requires: ***at a first location*** within the electronic version, detecting a reference to a second location; and, in response to the detected reference at the first location, ***embedding a hyperlink within at least part of the detected reference at the first location***, wherein the hyperlink is ***selectable*** by a user to cause displaying of the second location on the display device.

Accordingly, Ono fails to support a rejection of claim 1 under 35 U.S.C. § 102(e). In relation to claims 9 and 17, Ono is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 1, Ono is defective in establishing a prima facie case of obviousness. As between Ono and Applicant's specification, only Applicant's specification teaches the combination of elements in claim 1. In fact, Ono teaches away from such a combination. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

In relation to claims 9 and 17, Ono is likewise defective in establishing a prima facie case of obviousness.

Thus, a rejection of claims 1, 9 and 17 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 9 and 17.

Dependent claims 2, 5-8, 26, 28-30, 46 and 47 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 10, 13-16, 32, 34-36, 48 and 49 depend from and further limit claim 9 and therefore are allowable.

Dependent claims 18, 21-24, 38, 40-42, 50 and 51 depend from and further limit claim 17 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 5-10, 13-18, 21-24, 26, 28-30, 32, 34-36, 38, 40-42 and 46-51 is requested.

To the extent that this Accompanying Amendment results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

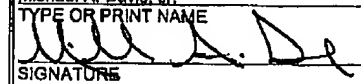
Michael A. Davis, Jr.
Registration No. 35,488

Date: March 3, 2009
Davis Law Group, P.C.
6836 Bee Caves Road
Suite 220
Austin, TX 78746
Telephone 512-306-8324
Facsimile 512-306-8374
Docket Number: 1005.11

I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below:

Fax Number: 571-273-8300

Michael A. Davis, Jr.
TYPE OR PRINT NAME



SIGNATURE

March 3, 2009
DATE OF TRANSMISSION